



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,839	06/30/2000	Michael A. Cleron	14531.70	2344

22913 7590 09/02/2004

WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER &  
SEELEY)  
60 EAST SOUTH TEMPLE  
1000 EAGLE GATE TOWER  
SALT LAKE CITY, UT 84111

EXAMINER
----------

DENNISON, JERRY B

ART UNIT	PAPER NUMBER
----------	--------------

2143

DATE MAILED: 09/02/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/607,839

Applicant(s)

CLERON ET AL.

Examiner

J. Bret Dennison

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 27-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 27-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

Art Unit: 2143

### **DETAILED ACTION**

1. This Action is a response to Amendment "B" of Application 09/607,839 filed 29 July 2004.
2. Claims 1-15 and 27-33 are presented for examination

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 9, and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Examiner was unable to locate in the spec where the term "separate" is defined as used in the claims ("separate from the server application").

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 and 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cotrille et al. (U.S. Patent Number 6,581,096) and Subramaniam et al (U.S. Patent Number 5,859,972).

3. Regarding claims 1, 9 and 27, Cotrille discloses in a server included in a network that also includes a client associated with specified attributes, a method of using a decision engine (server) to create a document for use by the client, the document being customized according to the specified attributes associated with the client, the method comprising the acts of:

receiving a request for a document at a server application, the server application being configured to generate the document from a script (Cotrille, col. 5, lines 50-55);

the server application generating a request for a decision engine, which is separate from the server application, to select content for the document based on at least one attribute of the client, and without specifying either the at least one attribute of the client or how the selection of content is to be made (Cotrille, col. 5, lines 25-30, Cotrille teaches the user providing authentication information, based on those attributes but not specifying them, the server application generates a request to the persistent data store for data);

the server application receiving from the decision engine an identification of the content that has been selected by the decision engine (Cotrille, col. 5, lines 60-64);

the server application creating the document and incorporating into the document the content that has been selected by the decision engine (Cottrille, col. 5 line 65 through col. 6, line 10, Cottrille teaches the community server assembling the community elements received from the persistent data store); and transmitting the document to the client (Cottrille, col. 6, lines 1-10).

Even though Cottrille implies a co-located community server, persistent data store, and authentication server, Cottrille does not explicitly provide the details of them being separate.

In an analogous art, Subramaniam provides a system containing a server that receives requests from clients and translates the requests to a plurality of formats in order to communicate a new request based from the client's original request. The server sends the new requests to separate (remote) data repositories or remote application programs and results are received therefrom (Subramaniam, col. 2 last paragraph).

Cottrille and Subramaniam are analogous because they both deal with a server, based on a client's request, generating and sending a new request to another engine which in turn responds with data requested, and the server then formatting a document to return to the client.

Therefore, it would have been obvious to one in the ordinary skill in the art at the time of the invention to combine Cottrille with Subramaniam in order to provide a server with a separate decision engine to return data based from a client's request for the benefit of putting less burden on the original server.

Art Unit: 2143

4. Regarding claims 2, 10, 11, 14, 15, 28, 29, 32, and 33, Cottrille and Subramaniam disclose the features of the invention, substantially as claimed, as described in claim 1, including wherein the act of receiving the identification of the content comprises the act of receiving additional script that, when executed, results in being incorporated into the document (Cottrille, col. 5, last paragraph, Cottrille teaches the persistent data store containing content which is transferred to the server and assembled with script at the server to create a home page for the user, Subramaniam, col. 2, last paragraph, Subramaniam discloses retrieving data from the remote application and transformed into a format for the user, meaning that the script retrieved from the remote application is run with a script at the original server to produce a document in the correct format for display to the client).

5. Regarding claim 3, Cottrille and Subramaniam disclose the features of the invention, substantially as claimed, as described in claim 2, including the act of assembling the script at runtime by concatenating said portion of script and said additional script (Cottrille, col. 6, lines 7-13, Cottrille teaches when a user request is made, the server dynamically creates and transfers a home page for the user).

6. Regarding claim 4, Cottrille and Subramaniam disclose the features of the invention, substantially as claimed, as described in claim 1, including wherein:  
the act of processing code associated with the script is performed by a server application operating at the server (col. 5, line 65 through col.6 line 12,

Art Unit: 2143

Cottrille teaches of a community server that dynamically assembles community elements into an HTML document at runtime.); and

requesting the decision engine to select content for the document based on attributes of the client is conducted without the server application communicating to the decision engine a value of said at least one attribute of the client (col. 6 lines 8-12, Cottrille teaches a server (decision engine) to create a community web page containing the client's community elements based on the client's user id.).

7. Regarding claim 5, Cottrille and Subramaniam disclose the features of the invention, substantially as claimed, as described in claim 4, including wherein requesting the decision engine to select content for the document based on attributes of the client is further conducted without the server application communicating to the decision engine criteria by which the decision engine is to select the content (col. 6 lines 8-12, Cottrille teaches of a server which runs code that dynamically creates a web page containing the client's community elements supplied by the server.).

8. Regarding claim 6, Cottrille and Subramaniam disclose the features of the invention, substantially as claimed, as described in claim 1, including wherein the document is a web page (col. 6, lines 14-18, Cottrille teaches of a community server which dynamically creates a web page containing community elements.)

Art Unit: 2143

9. Regarding claim 7, Cottrille and Subramaniam disclose the features of the invention, substantially as claimed, as described in claim 6, including wherein the content comprises at least one of text and an image that are determined to be appropriate for the client (col. 2, lines 5-6, Cottrille teaches of community elements that include non-real time based messaging which is a form of text.).

10. Regarding claim 8, Cottrille and Subramaniam disclose the features of the invention, substantially as claimed, as described in claim 6, including wherein the content comprises formatting that is determined to be appropriate for the client (col. 2, lines 9-15, Cottrille teaches of community management functions enabling users to format their community elements appropriately).

11. Regarding claims 12,13, 30, and 31, Cottrille and Subramaniam disclose the features of the invention, substantially as claimed, as described in claim 9, including the act of receiving a request from the client for the document (Cottrille, col. 6, lines 8-13) and transmitting the created document to the client (Cottrille, col. 6, lines 15-20).

Claims 1-15 and 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cottrille et al. (U.S. Patent Number 6,581,096) and Haverstock et al (U.S. Patent Number 6,678,738).



Art Unit: 2143

12. Regarding claims 1, 9 and 27, Cottrille discloses in a server included in a network that also includes a client associated with specified attributes, a method of using a decision engine (server) to create a document for use by the client, the document being customized according to the specified attributes associated with the client, the method comprising the acts of:

receiving a request for a document at a server application, the server application being configured to generate the document from a script (Cottrille, col. 5, lines 50-55);

the server application generating a request for a decision engine, which is separate from the server application, to select content for the document based on at least one attribute of the client, and without specifying either the at least one attribute of the client or how the selection of content is to be made (Cottrille, col. 5, lines 25-30, Cottrille teaches the user providing authentication information, based on those attributes but not specifying them, the server application generates a request to the persistent data store for data);

the server application receiving from the decision engine an identification of the content that has been selected by the decision engine (Cottrille, col. 5, lines 60-64);

the server application creating the document and incorporating into the document the content that has been selected by the decision engine (Cottrille, col. 5 line 65 through col. 6, line 10, Cottrille teaches the community server assembling the community elements received from the persistent data store); and transmitting the document to the client (Cottrille, col. 6, lines 1-10).

Even though Cotrille implies a co-located community server, persistent data store, and authentication server, Cotrille does not explicitly provide the details of them being separate.

In an analogous art, Haverstock provides a system containing a server that receives requests from clients and generates a new request to send to a separate non-HTML database, which chooses the data to return to the server. The server then generates the HTML page to send to the client (Haverstock, col. 3, lines 50-67).

Cotrille and Haverstock are analogous because they both involve generating documents using decision engines to obtain content based on client requests.

Therefore, it would have been obvious to one in the ordinary skill in the art at the time of the invention to combine Cotrille with Haverstock in order to provide a server with a separate decision engine to return data based from a client's request for the benefit of putting less burden on the original server.

### ***Response to Arguments***

13. Applicant's arguments with respect to claims 1-15, and 27-33 filed 29 July 2004 have been fully considered but they are not persuasive. Applicant's arguments include the failure of previously applied art to expressly disclose the teachings of a server application receiving a request for a document and then sending its own request to a separate decision engine for content based on client

Art Unit: 2143

attributes and without specifying the client attributes [see Response filed 29 July 2004, page 12, paragraph 1].

14. It is evident from the mappings found in the above rejection that the combination of Cottrille and Subramaniam disclose a client interacting directly with the community server of Figure 3 (Cottrille, col. 5, lines 20-22), requesting information from the community server (Cottrille, col. 5, lines 53-54). After the community server authenticates the client, the community server finds the reference to the community element requested by the client. The community server then sends a request including the indexed reference (reference is based on the client's request) to a persistent data store, or decision engine, wherein the persistent data store sends back the actual content of the community element. The community server then dynamically creates an HTML page containing the requested content and returns the assembled document to the client for display (Cottrille, col. 5, line 50 through col. 6, line 7). The community server, or server application, and the persistent data store, or decision engine are separate entities within the server. The persistent data store is a decision engine because its function is to decide which content is to be retrieved based on the reference request by the community server. Even though Cottrille implies a co-located community server, persistent data store, and authentication server, Cottrille does not explicitly provide the details of these entities being separate. However Subramaniam discloses wherein the server formats a request and sends the request to a separate server to obtain the content. Therefore the combination of

Art Unit: 2143

Cottrille and Subramaniam provides both the entities being separate within the same server, and separate in terms of being remotely separated.

15. It is evident from the mappings found in the above rejection that the combination of Cottrille and Haverstock disclose the teaching of a server application obtaining a client request, including client attributes and the server application requesting a decision engine, referred to as a Non-HTML Database, to select content for a document based on a request from the client. After the server application's request is made, the module retrieves the data and sends it back to the server application in HTML format. The server application then formats a response, including the information retrieved from the module, or decision engine, and sends it back to the client. Further, it is clear from the numerous teachings (previously and currently cited) that the provision for using "a decision engine" was widely implemented in the networking art.

16. As it is extremely well known in the networking art as already shown by Cottrille and Subramaniam as well as other prior arts of records disclosed, servers using decision engines as well as other claimed features of Applicant's invention. Applicant only claims a decision engine within a server to create a customized document based on at least one client attribute. By Cottrille and Subramaniam disclosing the use of a separate decision engine to obtain the content based on the request, it is obvious to Examiner that this function is provided.

17. Thus, Applicant's arguments drawn toward distinction of the claimed invention and the prior art teachings on this point are not considered persuasive.

Art Unit: 2143

It is also clear to the Examiner that Cotrille clearly teach the independent claims of the Applicant's claimed invention.

18. Applicant's arguments with respect to claims 1-15 and 27-33 are deemed moot in view of the following new grounds of rejection, necessitated by Applicant's amendment to the claims (i.e., ...*without specifying either the at least one attribute of the client or how the selection of the content is to be made*) which significantly affected the scope thereof.

19. Furthermore, as it is Applicant's right to continue to claim as broadly as possible their invention, it is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique. As it is extremely well known in the networking art as already shown by Cotrille and Subramaniam as well as other prior arts of records disclosed, using "a decision engine to select content" is taught as well as other claimed features of Applicant's invention. Applicant only claims the use of a decision engine to select content to create a customized document, which is well known in the art. By the rejection above, the applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claimed invention.

20. It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Art Unit: 2143

21. Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

### ***Conclusion***

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fortune (U.S. Patent Number 6,704,776) - Applicant's invention.

Dasan (U.S. Patent Number 5,761,662) – personalizing information based from user profiles.

Nehab et al. (U.S. Patent Number 6,029,182) – System for creating custom web pages based from a user's profile.

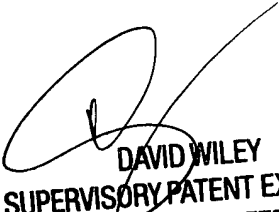
Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571)272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (703)308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2143

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JBD



DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100